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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,317	03/02/2004	Jay S. Walker	03-019	1814

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WALKER DIGITAL
2 HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER	
NGUYEN, BINH AN DUC	
ART UNIT	**PAPER NUMBER**
3713	

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/791,317	WALKER ET AL.	
	Examiner	Art Unit	
	Binh-An D. Nguyen	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,5-10,12-15 and 17-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,5-10,12-15 and 17-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *3 January 2006* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The Request for Continued Examination filed January 26, 2006 has been approved. Further, the Amendment filed January 26, 2006 has been received. According to the Amendment, the specification has been amended; new Figures 4, 5A-5D, 6A-6D, 7, and 8 have been submitted; 1, 3, 4, 11, and 16 have been cancelled; claims 2, 5-10, 12, 14, 15, and 17-20 have been amended; and new claims 21-24 have been added.

Note that, the amended limitations of bonus game(s) in claims 2, 5, and 12; and bonus game outcome and deleting selected indicia (Figures 7 and 8); and the newly submitted Figures 5A-5D raise the issue of new matters which have not been originally disclosed.

Currently, claims 2, 5-10,12-15, and 17-24 are pending in the application. Acknowledgment has been made.

Specification

The amendment filed January 26, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the new bonus game embodiments of Figures 5A-5D and the bonus game outcomes and deleting selected indicia in Figures 7 and 8 have not been originally disclosed. Note that, the

original specification only disclosed bonus payout for the basic game or meta-game; and the basic game or meta-game as disclosed are NOT bonus game.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 5-10,12-15, and 17-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations of "determining a position in a matrix for the plurality of symbols to form a plurality of bonus games,...; providing an award for a first winning bonus game...; removing selected symbols from the matrix...; providing a second winning bonus game outcome..." in claim 2; and "bonus game(s)" in claims 2, 5, and 12 have not been originally disclosed. Note that, the original specification only disclosed bonus payout for the basic game or meta-game; and the basic game or meta-game as being defined in the specification (page 2, line 31; page 3, line 1; and page 4, lines 15-17, 30-31) are NOT bonus game.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 5-10,12-15, and 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations of "determining a position in a matrix for the plurality of symbols to form a plurality of bonus games,...; providing an award for a first winning bonus game...; removing selected symbols from the matrix...; providing a second winning bonus game outcome..." in claim 2; and "bonus game(s)" in claims 2, 5, and 12 have not been clearly disclosed in the original specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-15 and 17-23, as best understood, are rejected under 35 U.S.C. 102(b) as anticipated by Barrie (5,980,384).

Referring to claim 12, Barrie teaches a method comprising: purchasing a prepaid gaming session having a predetermined plurality of basic game outcomes (paying for 6 paylines of the primary game)(6:13-55); generating the plurality of basic game outcomes, each basic game outcome comprising a plurality of randomly determined

symbols (Fig.1; Abstract, 1:66-3:19); providing an award for each of the plurality of basic game outcomes with a winning basic game outcome (Abstract; 4:13-28); determining, for each of the plurality of symbols, a respective position in a matrix, in which the matrix is defined by a plurality of rows and a plurality of columns, and in which each respective position is defined by one of the rows and one of the columns; displaying each of the plurality of symbols in the respectively determined position in the matrix; and providing an award for a winning bonus game outcome based on the determined positions of each of the plurality of symbols in the matrix (8:49-55).

Referring to claims 13-15 and 17-21, Barrie teaches determining, for each symbol, a respective position comprises determining, for each symbol, a respective position based on at least one rule (8:16-22); determining, for each of the plurality of symbols, a respective position based on at least one rule and a determined position of another symbol; determining, for at least one of the plurality of symbols, a respective position based on a determined position of another symbol identical to the at least one symbol (Fig.1); wherein the winning bonus game outcome comprises a predetermined winning symbol combination having at least two of the plurality of symbols in respective determined positions which define a row; wherein one of the predetermined symbol combinations comprises identical symbols (Fig.1); a predetermined winning symbol combination having at least two of the plurality of symbols in respective determined positions which define a column. (4:13-52);

Referring to claims 22 and 23 wherein one of the plurality of symbols replaces another one of the plurality of symbols in the same determined position in the matrix;

adding a row to the plurality of rows forming the matrix; and removing one of the rows from the plurality of rows forming the matrix, these limitations is inherent from Barrie's teaching wherein player can increase or decrease number of wagered pay-lines (6:24-55).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 5-10 and 24, as best understood, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saffari et al. (5,769,716).

Referring to claims 2 and 24, Saffari et al. teaches a wagering method comprising: generating a plurality of randomly selected symbols in a first area of a display (figs.1, 3A-3F, 5, and the Abstract); determining a position in a matrix for each of the plurality of symbols to form a plurality of bonus games the matrix located in a second area of the display; moving a first subset of the plurality of symbols from the first area of the display to the respective determined positions in the matrix; providing an award for a first winning game outcome based on the determined positions of the subset of the plurality of symbols in the matrix; removing selected symbols from the matrix wherein the removed symbols provide the determined positions for each of a

second subset of the plurality of symbols; moving the second subset of the plurality of symbols from the first area of the display to the respective determined positions in the matrix; and providing a second winning game outcome based on the determined positions of the second subset of the plurality of symbols and the remaining first subset of the plurality of symbols in the matrix (1:34-55; 2:55-3:24); and providing an award for each of the plurality of basic game outcomes having a predetermined symbol combination. Note that, the limitations of removing selected from the matrix (claim 2) and forming a plurality of basic game outcomes from subsets of the plurality of randomly selected symbols (claim 24) are inherent from Saffari's teaching of changing to a next game. Further, regarding the limitation of a the game is a bonus game (claim 2), it is well known in the gaming industry to utilize s primary game as a bonus game and vice versa. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to utilize the game of Saffari as a primary game or bonus game to enhance game payouts thus attract more game players.

Referring to claims 5-10 and 24, Saffari et al. teaches at least two of the plurality of symbols in a predetermined winning symbol combination having respectively determined positions that define a row (Fig.3); at least two of the plurality of symbols in a predetermined winning symbol combination having respectively determined positions that define a column (2:35-40); determining the position in the matrix comprising randomly determining the position (see Abstract); determining the a position in the a matrix comprises determining the position based on at least one rule (e.g., player selection or machine selection);determining the e position in the a matrix comprises

determining the position based on at least one rule and the determined position of a second symbol; determining the position for the second symbol in the matrix comprises determining the position based on the determined position of a first symbol, in which the first symbol and the second symbol are identical (Fig.5).

Response to Arguments

Applicant's arguments with respect to claims 2, 5-10,12-15, and 17-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BN

XUAN M. THAI
SUPERVISORY PATENT EXAMINER
TC3700